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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MANSFIELD, THOMAS L

ART UNIT

PAPER NUMBER

3624

NOTIFICATION DATE

DELIVERY MODE

04/30/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/731,571	Applicant(s) HENRICKSON ET AL.	
	Examiner THOMAS MANSFIELD	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 13-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This First Office action is in reply to the response to election/restriction filed on 13 February 2009.
2. Claims 1-23 were subject to restriction/election requirement.
3. Claims 1-22 (Group I) had been selected; however, upon further inspection it is determined that Claims 13-22 required further election/restriction and is explained below.
4. Claims 13-23 have been withdrawn from consideration.
5. Claims 1-12 are currently pending and have been examined.

Election/Restrictions

6. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a custom computer acquisition method, classified in class 705, subclass 10.
 - II. Claims 13-22, drawn to a computer replacement method, classified in class 705, subclass 10.

The inventions are distinct, each from the other because of the following reasons:

7. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I has separate utility including acquiring knowledge of a plurality of upgrade products which at least contain an upgrade over one or more components of said source computer, and receiving an order for a new target computer from a customer having dominion over said source computer and for making

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recommendations for upgrades to a computer. Group II has separate utility such as providing a source computer and a target computer and does not require the receiving an order for a new target computer from a customer having dominion over said source computer. See MPEP § 806.05(d).

8. Because these inventions are distinct for the reasons given above and the search required for Groups I and II are not required for each of the other Groups, restriction for examination purposes as indicated is proper.

9. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

10. During a telephone conversation with MacLane C. Key, Applicants Representative, on 24 April 2009 a provisional election was made without traverse to prosecute the invention of new Group I, claims 1-12, after the Examiner determined that an additional restriction/election was required between previously chosen Group I for Claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.

A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/329,868. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation, *causing the contents of a source computer to be surveyed* would have been obvious to one of ordinary skill in the art at the time of the invention. One would have been motivated to do so for the benefit of surveying the contents of a source computer.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

13. Claims 11 and 12 are objected to because of the following informalities: Claims 11 and 12 are duplicates of each other. For examination purposes, the Examiner will disregard Claim 12. Appropriate correction is required.

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. See *In Re Bilski*, 88 U.S.P.Q.2d 1385 (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise

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ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72.

Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform underlying subject matter.

Claim 1 must recite statutory subject matter within the body of the claim to fully support the causing, acquiring, recommending, enabling, migrating, installing, and processing steps recited in Claim 1. Dependent Claims 2-13 are rejected for the same reasons and rationale as Claim 1.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linberg (U.S. 6,442,433) in view of Fawcett (U.S. 6,073,214).

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With regard to Claim 1, Linberg teaches a *custom computer acquisition method comprising:*

a) causing the contents of a source computer to be surveyed (assess, monitor, or analyze various data and information relating to programmer 20 or its components) (see at least column 13, lines 24-34);

b) from said surveying, gaining knowledge of the components of said source computer (historical and performance data, usage information, instrument status information) (see at least column 14, lines 1-57);

c) acquiring knowledge of a plurality of upgrade products (upgrade software application) which at least contain an upgrade over one or more components of said source computer (see at least column 14, lines 1-57);

d) receiving an order for a new target computer from a customer having dominion over said source computer (can also schedule a parts replacement order for a component) (see at least column 14, lines 1-57);

e) recommending to said customer, at least one upgrade product to be installed on said target computer based upon knowledge of said source computer components and knowledge of said upgrade products (suggest modifications or adjustments) (see at least column 14, lines 1-57);

f) enabling said customer to choose at least one upgrade product to be installed on said target computer (alert the operator to change/maintain a component) (see at least column 14, lines 1-57);

g) migrating to said target computer, the source computer components chosen by the customer to be migrated (exporting it via one of the communications media) (see at least column 14, lines 1-57);

*h) installing the chosen upgrade products on said target computer (remotely installed in a specific component or sub-component of programmer **20**) (see at least column 14, lines 1-57);*

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i) processing said order (can also schedule a parts replacement order) (see at least column 14, lines 1-57);

Linberg does not specifically teach *j) following elements h) and i), causing a custom target computer to be delivered to said customer or said customer's agent*. Fawcett teaches *j) following elements h) and i), causing a custom target computer to be delivered to said customer or said customer's agent* in analogous art of computer software updating for the purposes of, "once the fee information is collected by the update service computer and is verified, the user can choose between immediate or delayed downloading of the new or new version of the computer software" (see at least column 10, lines 15-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the computer software updating method as taught by Fawcett with the operational and functional software upgrading method of Linberg. One of ordinary skill in the art would have been motivated to do so for the benefit of relieving the user from the burden of installing the computer software (Fawcett, see at least column 10, lines 43-63).

With regard to Claim 2, Linberg teaches *wherein said source computer components comprise a user state (events, conditions)* (see at least column 14, lines 1-32).

With regard to Claim 3, Linberg teaches *downloading a software tool from a remote location onto said source computer* (see at least column 14, lines 1-32); *and carrying out elements a) through i) with the aid of said software tool* (see at least column 14, lines 1-65).

With regard to Claim 4, Linberg teaches *wherein said software tool is an instrumentality under the dominion of a computer software and hardware vendor* (see at least column 14, lines 1-65).

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With regard to Claim 5, Linberg teaches: *loading a software tool onto said source computer; and carrying out elements a) through i) with the aid of said software tool* (see at least column 14, lines 1-65); *wherein said software tool is an instrumentality under the dominion of a computer software and hardware vendor, and wherein said upgrade products are directly available from said vendor* (see at least column 14, line 1 through column 15, line 39).

With regard to Claim 5, Linberg teaches: *loading a software tool onto said source computer* (see at least column 14, line 1 through column 15, line 39); *and carrying out elements a) through i) with the aid of said software tool* (see at least column 14, line 1 through column 15, line 39); *wherein said software tool is an instrumentality under the dominion of a computer software and hardware vendor, and wherein said upgrade products are available via an Internet link to an instrumentality of a separate entity from said vendor* (see at least column 14, line 1 through column 15, line 39).

With regard to Claim 7, Linberg does not specifically teach *said computer software and hardware vendor receives remuneration from said separate entity when an upgrade product is received from said instrumentality of said separate entity*. Fawcett teaches *said computer software and hardware vendor receives remuneration from said separate entity when an upgrade product is received from said instrumentality of said separate entity* in analogous art of computer software updating for the purposes of, “once the fee information is collected by the update service computer and is verified, the user can choose between immediate or delayed downloading of the new or new version of the computer software” (see at least column 10, lines 15-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the computer software updating method as taught by Fawcett with the operational and functional software upgrading method of Linberg. One of ordinary skill in the art would have been motivated to do so for the benefit of relieving the user from the burden of installing the computer software (Fawcett, see at least column 10, lines 43-63).

With regard to Claim 8, Linberg teaches *loading a software tool onto said source computer from a local storage medium comprising said software tool and product upgrades; and carrying out elements a) through i) with the aid of said software tool* (see at least column 14, line 1 through column 15, line 39).

With regard to Claim 9, Linberg teaches *sans element j), wherein elements c) and d) are performed first, follow by causing a target computer to be delivered to said customer or said customer's agent, wherein said target computer comprises loaded thereon, a software tool and product upgrades, and said method further comprising carrying out elements a), b), e), f), g), h), and i) with the aid of said software tool* (see at least column 14, line 1 through column 15, line 39).

With regard to Claim 10, Linberg teaches *activating at least one installed upgrade product via a telecommunication link* (see at least column 14, line 1 through column 15, line 39).

With regard to Claim 11/12, Linberg teaches *wherein said upgrade products comprise software* (see at least column 14, line 1 through column 15, line 39).

Conclusion

18. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Pierre et al. (U.S. 2004/0128203) discloses a scheme for creating and delivering a new customized computer system with the "personality" of a user's other computer system pre-installed.
- Selitrennikoff et al. (U.S. 6,301,612) discloses establishing one computer as a replacement for another computer.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS MANSFIELD whose telephone number is (571)270-1904. The examiner can normally be reached on Monday-Thursday 8:30 am-6 pm, alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on 571-272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./
Examiner, Art Unit 3624

24 April 2009
Thomas Mansfield

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624